

In re of Appln. No. 09/927,458
Response dated October 14, 2004
Reply to Office action of June 14, 2004

protein is a RIP-associated protein (RAP) encoded by a DNA sequence in a clone deposited in a depository, a fragment thereof which binds to RIP, an analog thereof having no more than 10 changes in the amino acid sequence of RAP, each said change being a substitution, deletion or insertion of an amino acid, which analog binds to RIP, or a derivative thereof by modification of a functional group which occurs as a side chain or a terminal group without changing one amino acid to another.

Claims 13, 15 and 16 have been rejected under 35 U.S.C. §102(e) as being anticipated by US patent 6,232,081 to Harper et al. The examiner states that SEQ ID NO:47 of Harper is a fragment of the claimed polypeptide of SEQ ID NO:2, and therefore anticipates the claims. This rejection is respectfully traversed.

The Harper patent is not available as a reference as its effective date as a reference is after the effective filing date of claims 13, 15 and 16. In the advisory action of September 26, 2003, the examiner stated:

As to the effective filing date of instant claims, the instant claim 13 is entitled to the effective filing date of 8/31/01 because the PCT/IL98/00125 filed 3/19/1998 does not have the support for a "RIP-associated protein (RAP) encoded by a DNA sequence [sic] in a clone deposited with Collection Nationale de Cultures de Microorganismes under accession number I-2706".

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However, this position of the examiner has been now reversed by the petition decision of October 12, 2004, with respect to this case. In this decision, Director Chambers states:

In summary, applicants are entitled to a claim of priority for the claimed deposited material and its proper sequence back to the date of the originally filed PCT application. The examiner is directed to accept applicant's affidavits relating to the deposited sequence with respect to this matter as providing proper support therefore.

Accordingly, the effective filing date of claim 13 is at least as early as the filing date of international application PCT/IL98/00125, which is March 19, 1998. Claims 15 and 16 must have this same effective filing date for the same reason. With respect to the examiner's statement with respect to claim 16 in the advisory action of August 19, 2003, that there is no support for "a composition" in the PCT application, the examiner's attention is invited to claims 23-25 of the international application as originally filed, which are composition claims. As the originally filed claims are part of the written description, it is clear that the international application contains written description for compositions. Accordingly, the examiner must now accept that the effective filing date for all of the claims under the present rejection is at least as early as March 19, 1998.

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The Harper patent has an effective filing date of October 15, 1998. In the advisory action of September 26, 2003, the examiner stated that claims 13, 15 and 16 are rejected under 35 U.S.C. §102(e) as being anticipated by Harper "using the contents, not the claims, of the issued patent which has supported [sic] in the specification of the parent." Respectfully, no part of an abandoned application is available as prior art as of the filing date of that abandoned application, unless a patent has issued properly claiming the benefit of that abandoned parent application under 35 U.S.C. 120. A patent is only available as of its effective filing date in view of 35 USC 102(e). A patent may only have the effective filing date of its parent for the purpose of 35 USC 102(e) if the patent is entitled to a right of priority to the earlier date under 35 USC 120. MPEP 2136.03 IV (Rev 2, May 2004) is entitled:

PARENT'S FILING DATE WHEN REFERENCE IS A
CONTINUATION-IN-PART OF THE PARENT

The first sub-heading is:

Filing Date of U.S. Parent Application Can
Only Be Used as the 35 USC 102(e) Date If It
Supports the Claims of the Issued Child

As stated in MPEP 2136.03 IV:

In order to carry back the 35 USC 102(e)
critical date of the U.S. patent reference
to the filing date of a parent application,
the U.S. patent reference must have a right
of priority to the earlier date under 35 USC

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120 ... and the parent application must
support the invention claimed as required by
35 USC 112, first paragraph.

This is supported by *In re Wertheim*, 646 F.2d 527, 537, 209
USPQ 554, 564 (CCPA 1981).

The parent application of Harper does not support
the invention claimed as required by 35 USC 112, first
paragraph. Thus, it is irrelevant that it contains a
disclosure of SEQ ID NO:47, as the disclosure of a protein in
an abandoned application to which an issued patent is not
entitled to priority under 35 USC 120 is not available as a
reference under any section of 35 USC 102.

In the advisory action of September 26, 2003, the
examiner stated:

If the reference SEQ ID NO:47 was patented,
SEQ ID NO:47 is entitled to the filing date
of the parent application under 35 U.S.C.
§120, which is October 16, 1997.

If the examiner is saying that had there been a claim in the
Harper patent to SEQ ID NO:47, the patent would then have been
entitled to an effective filing date of October 16, 1997, we
would heartily agree. But the fact is that there is no such
claim. 35 U.S.C. §102(e) and 35 U.S.C. §120 are not based on
hypotheticals, but on support for the actual claims. As no
patent exists claiming any subject matter which is present in
the abandoned parent application, no patent is entitled to
that effective filing date.

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The examiner's legal position as set forth in the advisory action is simply unsupported by any authority, and is certainly unsupported by the language of 35 U.S.C. §102(e) and 35 U.S.C. §120. The examiner's position is in clear disregard to the mandate of MPEP 2136.03 IV quoted above. The Forward to the Manual of Patent Examination Procedure states that this manual "contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application." The examiner has not explained why he is not following the mandate of the above-quoted portion of the MPEP. There is plainly and simply no legal support for the examiner's position. If the examiner continues to fail to comply with the clear mandate of the above-quoted portion of the MPEP, it is requested that the examiner cite authority of any kind for the examiner's position.

As the effective filing date of the Harper patent is October 15, 1998, in view of the fact that its claims are not supported by the disclosure of its parent application, this rejection is antedated by the effective filing date of the present application which, as ruled in the above referenced

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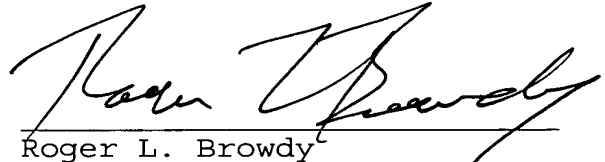
petition, is March 19, 1998. Reconsideration and withdrawal of this rejection is therefore respectfully urged.

It is submitted that all of the claims now present in the case clearly define over all of the references of record that have an effective filing date prior to the effective filing date of the present claims. Reconsideration and allowance are therefore earnestly solicited.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By


Roger L. Browdy
Registration No. 25,618

RLB:jab
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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